

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of	:	Customer Number: 20277
	:	
Tatsuya EGUCHI, et al.	:	Confirmation Number: 5731
	:	
Application No.: 09/593,060	:	Group Art Unit: 2626
	:	
Filed: June 13, 2000	:	Examiner: Qi HAN
	:	
For: TRANSLATING APPARATUS	:	

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Pre-Appeal Brief Request for Review is being filed in response to the final Office Action dated August 15, 2008. A Notice of Appeal is being filed concurrently herewith.

Claims 1, 3-14 and 16-18 are pending in this application.

Claims 1, 4-14 and 16-18 are patentable over Yamauchi et al. (USP No. 5,701,497) in view of Flores et al. (USP No. 6,370,498).

The Examiner's Position:

The Examiner has rejected claims 1, 4-14 and 16-18 under 35 U.S.C. § 103(a) as being unpatentable over Yamauchi et al. (USP No. 5,701,497) in view of Flores et al. (USP No. 6,370,498).

In the rejection of claims, 1, 6, 11, 14 and 17, the Examiner admits that Yamauchi fails to disclose in the second mode "each group of the document data comprising a printed document in

the original language and printed documents of the translated document data translated in each of the plurality of languages with each of the printed documents being distinct from one another.”

However, it is alleged that based on Yamauchi’s multi-language translation system that can output printable documents in the original language and one translated language, combined with Flores’ computer and database based multi-language translation system that can generate and output (display) documents in multiple translated languages, one skilled in the art would have readily combined the two teachings so that the combined system could operate the functionality for grouping, sorting, and printing the stored/generated multiple language documents in the same or similar way as that of claims 1, 6, 11, 14 and 17 of the present disclosure.

Appellants Position:

One aspect of claims 1, 6, 11, 14 and 17 is that the translating apparatus translates document data from one language into one or more languages and outputs the results in a group of printed documents in each of the languages, with each of the printed documents being distinct from one another.

It is alleged that Yamauchi and Flores disclose the above recited feature. Yamauchi discloses outputting an original language and a translated document in pairs. For example, col. 4, lines 37-60 discuss how a document written in a first language is translated to a second language and output in a variety of ways as a pair of translations. However, Yamauchi fails to disclose the outputting of a group of printed documents consisting of the original document and the translated document data in each of a plurality of languages, each as separate documents.

In contrast, the present disclosure outputs documents in a group of documents having the original language and one or more of other languages. For example, as shown in Fig. 3 which

corresponds to claim 1, original document A in one language is translated into languages B and C and output as a group of documents containing languages A, B and C.

Moreover, Figs. 4 and 5 of the present specification, which correspond to claims 6, 11 and 17 show a group of original documents consisting of page 1 (representing language A), page 2 (language B) and page 3 (language C) output as a group as an image of pages 1-3 all in language A. However, nowhere does Yamauchi disclose these features. Moreover, Flores fails to remedy this deficiency. Although it is alleged that Flores teaches the display of two or more separate languages, Flores fails to output a group of printed documents having a separate document in the original language and a plurality of other separate documents for each of the plurality of other languages, or a group of printed documents which have translated one or more languages into one different language and output the documents. As is clearly shown in Figs. 5A and 5B, Flores discloses only one document containing translated materials. As such, Flores fails to teach or suggest a translating device with each of the printed documents being distinct from one another, or separation or separate grouping of the translated documents from the original documents to make them distinct.

Accordingly, the combination of Yamauchi and Flores fails to disclose the limitation of claims 1, 6, 11, 14 and 17 to output the translated document data by groups, each group of the translated document data comprising a printed document in the original language and printed documents of the translated document data translated in one or a plurality of languages with each of the printed documents being distinct from one another. Accordingly, Applicants respectfully request that the § 103 rejection of claims 1, 6, 11, 14 and 17 be withdrawn.

As is well known, in order to establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. As Yamauchi and Flores fail to disclose the above cited limitations, then based on the foregoing, it is submitted that Yamauchi, alone or in combination with Fujita or Flores does not render claims 1, 6, 11, 14, 17, or any claim dependent thereon obvious.

Furthermore, it is noted that while the Examiner alleges that Applicants are arguing against the individual references and not the combination of references, Applicants would point out that in order for a *prima facie* case of obviousness to be valid, all elements of the claims must be present in the cited prior art. If a cited prior art reference which is alleged to contain one of these elements, and Applicants show that the reference indeed does not disclose this element, then the Applicants have rebutted the *prima facie* case of obviousness.

All dependent claims are allowable as being dependent upon an allowable independent claim.

Under Federal Circuit guidelines, a dependent claim is nonobvious if the independent claim upon which it depends is allowable because all the limitations of the independent claim are contained in the dependent claims, *Hartness International Inc. v. Simplimatic Engineering Co.*, 819 F.2d at 1100, 1108 (Fed. Cir. 1987). Accordingly, as claim 1 is patentable for the reasons set forth above, it is respectfully submitted that all pending dependent claims are also in condition for allowance.

Application No.: 09/593,060

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

McDERMOTT WILL & EMERY LLP

Michael E. Fogarty Reg No 53,308
for Michael E. Fogarty
Registration No. 36,139

600 13th Street, N.W.
Washington, DC 20005-3096
Phone: 202.756.8000 MEF/NDM:kap
Facsimile: 202.756.8087
Date: December 9, 2008

**Please recognize our Customer No. 20277
as our correspondence address.**